



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,544	06/29/2000	Colin S. Cole	3797.86783	8016

28319 7590 09/15/2005

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
ELEVENTH STREET
WASHINGTON, DC 20001-4597

EXAMINER

STRANGE, AARON N

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,544

Applicant(s)

COLE ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ET

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/6/2005 have been fully considered but they are not persuasive.
2. With regard to claims 1, 16, and 20, and Applicant's assertion that "there is no reasonable interpretation for the term 'contained' that is not adequately supported by the description of 'attached' files found in the specification" (Page 6, Lines 25-27 of Remarks), the Examiner respectfully disagrees. The section of the specification cited by Applicant in alleged support of this assertion, (Specification, p. 11), states that a file may be attached by *describing* the attachment between attachment tags, including information such as the filename and a description of it. It is clear from this section that the attachment itself is not contained in the software envelope. At most, a reference to and description of the attachment is contained within the envelope.
3. Applicant's arguments with regard to claim 12 (Page 6, Line 29 to Page 7, Line 4 of Remarks) are not persuasive for the same reasons discussed above with regard to claims 1, 16, and 20.
4. With regard to claims 1, 6-8, 10, 16, 19, 20, and 22, and Applicant's assertion that "Dutta does not teach or suggest a plugin in accordance with claim 1" (Page 8, Line 4 of Remarks), Applicant is reminded that one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Hughes teaches the use of a markup language data file (Col 8, Lines 35-39). Dutta was cited to teach inclusion of a plugin with a data file that a recipient of that file does not have the capability to view. Including the plugin allows the recipient to properly view the file and process accordingly.

With regard to Applicant's assertion that "Dutta's plugin does not correspond to a schema" (Page 8, Lines 9-10 of Remarks), the Examiner respectfully disagrees. Applicant argues that a schema "defines the structure and type of contents in a data file" (Page 8, Line 6 of Remarks). Therefore, it is clear that Dutta's plugin does correspond to a schema. For example, Dutta teaches including a PNG viewer with a x.PNG file. Since the file is in PNG format, the PNG viewer plugin must correspond to a schema defining the structure and type of contents in x.PNG in order to understand the file.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dutta clearly

discloses that including a plugin to properly interpret a data file is advantageous since it allows the recipient to understand the file without requiring conversion to another format. This can make it faster for a client to receive data or even eliminate the need for conversion at the source (Dutta, Col 7, Line 63 to Col 8, Line 22).

6. With regard to Applicant's assertion that "there is no motivation to add plugins to Hughes, since Hughes already alleges to have a system for interpreting messages transmitted between incompatible systems, and does so without using plugins in any way." (Page 9, Lines 17-19 of Remarks), the Examiner respectfully disagrees. Hughes merely discloses the use of an "interpretation file", which may be considered a plugin on its own, that is used to interpret the message body. Even if the interpretation file were not considered to be a plugin, the mere fact that Hughes teaches another way of interpreting messages transmitted between incompatible systems does not mean that the system would not benefit from combination with the system disclosed by Dutta. Dutta provides a means of transmitting messages between incompatible systems that does not require converting the messages into any other format, which is very advantageous, since there is no risk of data loss due to conversion.

7. With regard to claim 4, and Applicant's assertion that Chen does not suggest "generating a return document with data which could be considered state information" (Page 11, Lines 3-4 of Remarks), the Examiner respectfully disagrees. Chen discloses that the return document has a destination address determined by state information,

Art Unit: 2153

since the fields of the return document are pre-filled with data from the first message, such as source address information (Col 3, Lines 50-60 and Col 4, Lines 40-68).

With regard to Applicant's assertion that state information is distinguishable from the source/destination addresses of the message (Page 10, Lines 26-27 of Remarks), it is noted that such limitations do not appear in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The source/destination addresses are state information, since they may be used to correlate individual messages with specific exchanges, as described by Applicant.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-10, 12-16, and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2153

10. With regard to claim 1, the limitation “a first software envelope containing the data file and a plugin” is not supported by the specification. The specification states only “In one embodiment of the invention, a plugin or parser may be attached to the software envelope”. Creating a software envelope *containing a plugin* is a very different operation from and is not supported by *attaching a plugin* to a software envelope.

11. With regard to claim 12, the limitation “a pluginwith the predetermined schema” is not supported by the specification. The specification fails to provide support for a data structure containing a plugin with the claimed characteristics in addition to the other 4 fields recited in claim 12. The specification describes a data structure containing the first 3 fields on Page 3 of the specification, by at no point does it describe including a plugin in the data structure.

12. Claims 16 and 20 have similar recitations to claim 1, and are rejected under the same rationale.

13. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2153

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1,6-8,10,16,19,20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,122,372) in view of Dutta et al. (US 6,615,212).

16. With regard to claim 1, Hughes discloses a method for exchanging data between a source location and a destination location (column 5, lines 39-41) comprising: generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39); generating a first software envelope containing the data file (column 6, lines 6-14); transmitting the data file software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5); and creating an object from the data file with a plugin corresponding to the predetermined schema (column 9, lines 25-32 and 47-57). However, Hughes fails to specifically disclose that the software envelope contains the plugin.

Dutta teaches including a plugin with a data file in response to a request for a data file which the client does not have the capability to view. The plugin is transmitted along with the data object so that the client may install the plugin and view the data file correctly (Col 7, Line 63 to Col 8, Line 11). This would have been an especially advantageous addition to the system disclosed by Hughes since it would allow data files to be packaged with the appropriate plugin to ensure that the client can properly understand them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the appropriate plugin with the data file in order to ensure that the client could properly understand the data file.

17. With regard to claim 6, 19, and 22, Hughes further discloses wherein the markup language comprises standard generalized markup language (SGML) (Col 8, Lines 35-39).

18. With regard to claim 7, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via electronic mail (Col 8, Lines 43-44).

19. With regard to claim 9, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via an intermediate server (Col 5, Lines 48-52).

20. With regard to claim 10, Hughes further discloses a computer-readable medium having computer-executable instructions for performing the steps recited in claim 1 (Note that it is inherent that in order to perform the method steps there must be a computer-readable medium with computer-executable instructions.).

21. With regard to claim 16, Hughes discloses a method for creating data at a source location to transmit to a destination location (column 5, lines 39-41), comprising the

steps of: generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39); generating a software envelope containing the data file (column 6, lines 6-14); identifying a plugin corresponding to the predetermined schema that creates an object from the data file (column 9, lines 25-32); and transmitting the software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5). However, Hughes fails to specifically disclose that the software envelope contains the plugin.

Dutta teaches including a plugin with a data file in response to a request for a data file which the client does not have the capability to view. The plugin is transmitted along with the data object so that the client may install the plugin and view the data file correctly (Col 7, Line 63 to Col 8, Line 11). This would have been an especially advantageous addition to the system disclosed by Hughes since it would allow data files to be packaged with the appropriate plugin to ensure that the client can properly understand them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the appropriate plugin with the data file in order to ensure that the client could properly understand the data file.

22. With regard to claim 20, Hughes discloses a method for extracting data from a file transmitted from a source location, comprising the steps of: receiving a software envelope containing a data file marked up with a markup language in accordance with a predetermined schema (column 5, lines 64-67 – column 6, lines 1-5); and creating an

object from the data file with the plug-in (column 9, lines 25-32). However, Hughes fails to specifically disclose that the software envelope contains the plugin.

Dutta teaches including a plugin with a data file in response to a request for a data file which the client does not have the capability to view. The plugin is transmitted along with the data object so that the client may install the plugin and view the data file correctly (Col 7, Line 63 to Col 8, Line 11). This would have been an especially advantageous addition to the system disclosed by Hughes since it would allow data files to be packaged with the appropriate plugin to ensure that the client can properly understand them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the appropriate plugin with the data file in order to ensure that the client could properly understand the data file.

23. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,122,372) in view of Dutta et al. (US 6,615,212) in further view of Chen et al. (US 6,507,856).

24. With regard to claim 2, while the system disclosed by Hughes in view of Dutta shows substantial features of the claimed invention (discussed above), it fails to disclose generating a second software envelope from the information contained in the first software envelope.

Chen discloses a system for exchanging messages over a network including

Art Unit: 2153

automatically generating a second software envelope from the information contained in the first software envelope (Col 3, Lines 50-60). This would have been an advantageous addition to the system disclosed by Hughes in view of Dutta since it would have provided greater efficiency when transferring a document back to the original destination.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a second software envelope from the information contained in the first software envelope since it would have provided greater efficiency when transferring a document back to the original destination.

25. With regard to claim 3, Chen further discloses generating a second envelope having a destination address matching the source address of the first envelope (Col 3, Lines 50-60).

26. With regard to claim 4, Chen further discloses generating a second software envelope having a destination address determined by the state information (Col 3, Lines 50-60).

27. Claims 5, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,122,372) in view of Dutta et al. (US 6,615,212) in further view of Lection et al. (US 6,446,110).

28. With regard to claims 5, 18, and 21, while the system disclosed by Hughes in view of Dutta shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the markup language comprises extensible markup language (XML).

Lecture discloses using the well-known markup language XML to generate a data file (Col 6, Lines 34-35 and Fig 13A). This would have been an advantageous addition to the system disclosed by Hughes and Dutta since XML allows great flexibility in organizing and presenting information in the data file.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use XML as the markup language in the system disclosed by Hughes and Dutta since it is a well-known language that allows great flexibility in organizing and presenting information in the data file.

29. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,122,372) in view of Dutta et al. (US 6,615,212) in further view of Official Notice.

30. With regard to claim 8, while the system disclosed by Hughes in view of Dutta shows substantial features of the claimed invention (discussed above), including that the messages may be transmitted "by HTML" (Col 8, Lines 43-47), it fails to specifically recite that the step of transmitting comprises transmitting the software envelope via HTTP.

The Examiner takes Official Notice that transmitting messages via HTTP is old

Art Unit: 2153

and well-known in the art. HTML messages are usually transmitted via HTTP, during operations such as loading a web page. HTTP would have been the most common means of transmitting HTML at the time the invention was made, and would almost certainly have been used.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use HTTP to transmit HTML formatted messages since HTTP is the most common transport protocol for HTML.

31. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lektion et al. (US 6,446,110) in view of Dutta et al. (US 6,615,212).

32. With regard to claim 12, Lektion discloses a computer-readable medium having stored thereon a data structure comprising: a data field containing address information (see column 9, line 19 ("host port number")); a data field containing the identification of a predetermined schema (see column 9, lines 4-6); a data field containing a data file formatted with a markup language in accordance with the schema (figures 13A-13E, col. 10 lines 14-19); and a data field containing manifest information corresponding to the information contained in the data file data field (see figure 10A-10E, column 9, lines 7-9 and 22-30). However, Lektion fails to disclose that the data structure comprises a plugin configured to create an object from the data file in accordance with the predetermined schema.

Dutta teaches including a plugin with a data file in response to a request for a data file which the client does not have the capability to view. The plugin is transmitted along with the data object so that the client may install the plugin and view the data file correctly (Col 7, Line 63 to Col 8, Line 11). This would have been an especially advantageous addition to the data structure disclosed by Lektion since it would allow data files to be packaged with the appropriate plugin to ensure that the client can properly understand and utilize them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the appropriate plugin with the data file in order to ensure that the client could properly understand and utilize the data file.

33. With regard to claim 13, Lektion further discloses a data field containing state information (see column 9, lines 16-18).

34. With regard to claim 14, Lektion further discloses wherein the state information contains address information (see column 9, line 19 ("host port number")).

35. With regard to claim 15, Lektion further discloses wherein the address information contains an address for replying to a message (see Fig. 4; Note that the double arrows show that the datastreams are going in both directions between the source and destination and therefore the address information must contain an address for replying to the datastream message in order for it to be transmitted back to the host).

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
9/6/2005



KRISNA LIM
PRIMARY EXAMINER